



## UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/7925, 326	09/08/97	LEBAUT	G 24124996/09

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EXAMINER

OSWECKI, J

ART UNIT

1613

PAPER NUMBER

DATE MAILED: 07/15/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 08/925,326	Applicant(s) Lebaut et al.
Examiner Jane Oswecki	Group Art Unit 1613

Responsive to communication(s) filed on \_\_\_\_\_.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 1-8 are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

Claims 1-8 are pending in the application.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to compounds of formula I, classified in class 548, subclass 469+ and class 564, subclass 123+.
- II. Claim 1, drawn to compounds of formulae I and II, classified in class 546, subclass 249+.
- III. Claim 1, drawn to compounds of formulae I and III, classified in class 544, subclass 358+.
- IV. Claim 8, drawn to a first process for preparing compounds of formula I, classified in classes 544, 546, 548 and/or 564, various subclasses depending on the product prepared.
- V. Claim 8, drawn to a second process for preparing compounds of formula I, classified in classes 544, 546, 548 and/or 564, various subclasses depending upon the product prepared.

Claims 2-7 will be examined as commensurate in scope with the group elected.

### ***Distinctness***

The inventions are distinct, each from the other because of the following reasons: the inventions of Groups I- III are distinct, each from the other, because they differ in structure

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and/or element so as to be patentably distinct and a prior art reference anticipating but one of the groups would not render obvious the other groups under 35 U.S.C. 103. Groups I-III are unrelated because divergent classes of compounds exist (M.P.E.P. 806.04(f)), and each group of compounds is capable of supporting its own patent.

Inventions of Groups I-III and either IV or V are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product made can be made by another, materially different process as taught in U.S. Pat. 3,691,194 to Papanastassiou et al.

The inventions of Groups IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the inventions of Groups IV and V are unrelated since they are two separate and distinct processes for preparing the same compounds. They are not capable of use together but, instead, as alternatives to one another.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for any of Groups I-V is not required for any other of the same Groups I-V, restriction for examination

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purposes as indicated is proper. In addition, it would be an undue burden on the examiner to search all of the inventions in this application.

***Telephone Election***

A telephone call was made to Dr. Ann Hobbs on June 29, 1998, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

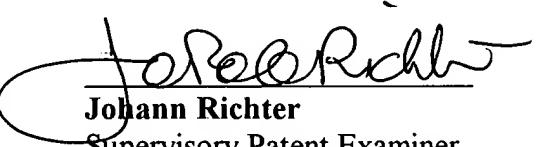
***Telephone Inquiry Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Oswecki whose telephone number is (703)305-7152. The examiner can normally be reached Monday through Thursday from 7:30 AM to 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, can be reached at (703)308-4532. The telephone number for this Group is (703)308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1235.

  
**Johann Richter**  
Supervisory Patent Examiner  
Group 1600

JCO  
July 7, 1998